APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,448	01/09/2002	Edwin Kong-Sun Ho	005925.P001	8466

7590 12/14/2004	**EXAMINER**
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ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/044,448	HO ET AL.
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 January 2004</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-5, 7-10, 12, 14-16, 18-21, 23, 25-29 and 31-34 are rejected under 35 U.S.C. 102(e) as being unpatentable over by Mehta et al. (US 2002/0131404 A1) (Mehta) in view of Little et al. (US 2002/0055852) (Little).

Claims 1 and 12. Mehta teaches a method and system for maintaining and distributing wireless applications to mobile devices, said system including: a computer network, a provisioning server, and a deployment server having "push" behavior capability [0110], [0132]; said method further comprising: receiving a request (call) for an application from a customer's mobile device; and responding to the call based upon information identified for response [0136]; [0138].

Mehta does not specifically teach that responding to the request (call) from the customer's mobile device includes initiating a *dialog* between the server and the mobile device.

Little teaches a method and system for selecting and presenting information to wireless devices, wherein a dialog is established between the interactive voice response server and the wireless device [0037].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mehta to include that responding to the request (call) from the customer's mobile device includes initiating a dialog between the server and the mobile device, as disclosed in Little, because it would advantageously allow to

incrementally build up a customer's request until sufficient information has been
retrieved for processing, as specifically indicated in Little [0037].

Furthermore, Mehta teaches:

Claims 3 and 14. Identifying the subscriber who sent the request [0136].

Claims 4 and 15. Determining whether the device has the resources and other
capabilities specified by the application profile that corresponds to the requested
application [0136].

Claims 5 and 16. Determining compatible file formats for the identified
subscriber device [0148].

Claims 7 and 18. Based on determined information related to the resources and
other capabilities specified by the application profile (first subset), selecting a remote
application host to select the requested application (Fig. 5; [0065]; [0136]). Information
as to *first subset of the information* is non-functional language and given no patentable
weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that
would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217
USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d
1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material
is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior
art only with respect to non-functional descriptive material that cannot alter <u>how</u> the
process steps are to be performed.

Claims 8 and 19. Based on determined information related to a designated by a
subscriber list of content, which can be downloaded (second subset), identifying
applications matching said list [0006]. Information as to *second subset of the information*
is non-functional language and given no patentable weight. Non-functional descriptive
material <u>cannot</u> render non-obvious an invention that would otherwise have been
obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)
In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The
specific example of non-functional descriptive material is provided in MPEP 2106,
Section VI: (example 3) a process that differs from the prior art only with respect to non-

functional descriptive material that cannot alter how the process steps are to be performed.

Claims 9 and 20. Based on determined information related to a designated by a subscriber list of content, which can be downloaded (second subset), identifying applications matching said list [0006]. Information as to specific content of said applications, including *one of a product, a location, a person, and a group of people* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

Claims 10 and 21. Selecting the information via cell phone interface (Fig. 2, [0063]).

Claim 23. Mehta teaches a computer readable medium containing instructions which when executed by a computer causing: receiving a request (call) for an application from a customer's mobile device; and responding to the call by providing, by a deployment server having "push" behavior capability ([0110], [0132]) an application, chosen based upon information identified for response [0136]; [0138].

Mehta does not specifically teach that responding to the request (call) from the customer's mobile device includes initiating *a dialog* between the server and the mobile device.

Little teaches a method and system for selecting and presenting information to wireless devices, wherein a dialog is established between the interactive voice response server and the wireless device [0037].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mehta to include that responding to the request (call) from the customer's mobile device includes initiating a dialog between the server and

the mobile device, as disclosed in Little, because it would advantageously allow to incrementally build up a customer's request until sufficient information has been retrieved for processing, as specifically indicated in Little [0037].

Claim 25. Identifying the subscriber who sent the request [0136].

Claim 26. Selecting the information via cell phone interface (Fig. 2, [0063]).

Claim 27. Mehta teaches a computer readable medium containing instructions which when executed by a computer causing: receiving over a computer network information related to request (call) for an application from a customer's mobile device; and responding to the call by providing an application to be selected based upon information identified for response [0136]; [0138].

Mehta does not specifically teach that responding to the request (call) from the customer's mobile device includes initiating *a dialog* between the server and the mobile device.

Little teaches a method and system for selecting and presenting information to wireless devices, wherein a dialog is established between the interactive voice response server and the wireless device [0037].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mehta to include that responding to the request (call) from the customer's mobile device includes initiating a dialog between the server and the mobile device, as disclosed in Little, because it would advantageously allow to incrementally build up a customer's request until sufficient information has been retrieved for processing, as specifically indicated in Little [0037].

Claim 28. Determining whether the device has the resources and other capabilities specified by the application profile that corresponds to the requested application [0136].

Claim 29. Determining compatible file formats for the identified subscriber device [0148].

Claim 31. Based on determined information related to the resources and other capabilities specified by the application profile (first subset), selecting a remote application host to select the requested application (Fig. 5; [0065]; [0136]). Information

as to *first subset of the information* is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter <u>how</u> the process steps are to be performed.

Claim 32. Based on determined information related to a designated by a subscriber list of content, which can be downloaded (second subset), identifying applications matching said list [0006]. Information as to *second subset ofthe information* is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter <u>how</u> the process steps are to be performed.

Claims 33. Based on determined information related to a designated by a subscriber list of content, which can be downloaded (second subset), identifying applications matching said list [0006]. Information as to specific content of said applications, including *one of a product, a location, a person, and a group of people* is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-

functional descriptive material that cannot alter <u>how</u> the process steps are to be performed.

Claim 34. Mehta teaches a computer readable medium containing instructions which when executed by a computer causing: receiving information from a deployment server having "push" behavior capability ([0110], [0132]), said server has received a request (call) for an application from a customer's mobile device; responding to the call by providing an application selected based upon information identified for response [0136]; [0138].

Mehta does not specifically teach that responding to the request (call) from the customer's mobile device includes initiating a *dialog* between the server and the mobile device.

Little teaches a method and system for selecting and presenting information to wireless devices, wherein a dialog is established between the interactive voice response server and the wireless device [0037].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mehta to include that responding to the request (call) from the customer's mobile device includes initiating a dialog between the server and the mobile device, as disclosed in Little, because it would advantageously allow to incrementally build up a customer's request until sufficient information has been retrieved for processing, as specifically indicated in Little [0037].

Claims 2, 6, 13, 17, 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta in view of Little and further in view of Larsson (US 6,304,757 B1).

Claims 2, 13 and 24. Mehta in view of Little teach all the limitations of claims 2, 13 and 24, except specifically teaching *terminating the call prior to an answering of the call*.

Larsson teaches a telecommunications method and system, including a plurality of mobile users and a telecommunications network, wherein, when a subscriber

notifies the telephone exchange that he has transferred to an other area, he/she *terminates the connection before the telephone exchange unit has answered the call,* thereby avoiding cost to the telephone exchange unit (C. 8, L. 53-60).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mehta in view of Little to include *terminating the call prior to an answering of the call,* as disclosed in Larsson, because it would advantageously allow subscribers to avoid unnecessary cost, as specifically indicated in Larsson.

Claims 6, 17 and 30. Mehta in view of Little teach all the limitations of claims 6, 17 and 30, except specifically teaching that said format includes *two-way SMS.*

Larsson teaches said telecommunications method and system, wherein communication channels employed can be SMS.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mehta in view of Little to include that said mobile devices include SMS capability, as disclosed in Larsson, because it would advantageously allow to communicate without incurring excessive costs.

Claims 11, 22 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta in view of Little and further in view of Thornton (US 6,751,454 B2).

Claims 11, 22 and 35. Mehta in view of Little teach all the limitations of claims 11, 22 and 35, except specifically teaching that said response include *instructing the mobile device to connect to the server.*

Thornton teaches a method and system for sampling audio recording on a cell phone, wherein, after stablishing a first data connection to the data server computer, if a consumer wants to select a particular audio of interest while navigating through a menu system, the data server computer then instructs the wireless device to terminate the first data connection and establish a voice connection with an audio server computer (C. 2, L. 40-42; C. 7, L. 15-25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mehta in view of Little to include that said response include *instructing the mobile device to connect to the server,* as disclosed in Thornton, because it would advantageously allow subscribers to review or "try" various applications prior to purchasing them, thereby decrease the amount of "returns ".

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

European Patent EP 1 037 447 A2 to Hitching et al. teaches a method for utilizing subscriber status and location information in a wireless network.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:
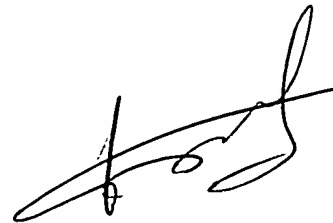
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687   [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
Art Unit 3629

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12/09/2004